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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,313	03/29/2001	Nagayuki Takao	0152-0555P	1864
2292	7590	05/17/2004	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			SHOSHO, CALLIE E	
			ART UNIT	PAPER NUMBER
			1714	

DATE MAILED: 05/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/820,313

Applicant(s)

TAKAO ET AL.

Examiner

Callie E. Shosho

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 April 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: 6,7,16 and 17.

Claim(s) rejected: 1-4,8,9,13-15 and 18-22.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

Callie E. Shosho  
Primary Examiner  
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**Attachment to Advisory Action**

1. Applicants' amendment filed 4/29/04 has been fully considered but it has not been entered given that the amendment raises new issues that would require further consideration. Applicants' amendment while removing the rejection of record with respect to Ikeda et al. (U.S. 5,952,429) also amends the claims such that previously withdrawn prior art would again be applicable against the claims.

Specifically, in the amendment filed 4/29/04, claim 1 has been amended to recite the limitations of previously presented claim 6 and claim 16, which were cancelled. It is noted that such amendment, if entered, would overcome the rejection of record set forth in paragraph 3 of the office action mailed 3/4/04, namely, the rejection utilizing Ikeda et al.

However, in the amendment filed 4/29/04, applicants also amend claim 1 so that the claim no longer requires that the silicone graft polymer have acid value of 5-100 KOH mg/g, hydroxyl value of 5-100 KOH mg/g, and amine value of 5-100 KOH mg/g. The claim is amended such that it is required that the silicone graft polymer only has acid value of 5-100 KOH mg/g or hydroxyl value of 5-100 KOH mg/g. Such amendment clearly changes the claim from that previously presented in the amendment filed 2/13/04 and thus, would require further consideration. This is especially significant given that prior art was previously withdrawn as applicable references against the claims in light of the recitation that the silicone graft polymer have acid value, hydroxyl value, and amine value as described above.

That is, in the amendment filed 2/13/04, applicants amended claim 1 to require that the silicone graft polymer have acid value of 5-100 KOH mg/g, hydroxyl value of 5-100 KOH mg/g, and amine value of 5-100 KOH mg/g. Based on this amendment, the rejections of record

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utilizing Tsubuko et al. (U.S. 5,952,048) and Ryntz et al. (U.S. 4,673,718) were removed.

However, given that applicants have now removed the recitation requiring that the silicone graft polymer have acid value, hydroxyl value, and amine value from claim 1, the combination of Tsubuko et al. and Ryntz et al. would again be applicable against the present claims for the reasons set forth in paragraphs 4-5 of the office action mailed 7/16/03. While claim 1 has been amended to include the limitations of claim 6 and claim 16, it is noted that the combination of Tsubuko et al. and Ryntz et al. meet these limitations (see paragraphs 4-5 of the office action mailed 7/16/03).



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Art Unit 1714

CS  
5/14/04